

Vancura apparently describes a knowledge base game where players use their knowledge to help them win games. The disclosure describes casino games as being either chance based or knowledge based and proceeds to describe numerous knowledge based games.

Brossard apparently describes a gaming device that outputs audio and visual performances of a celebrity. It also apparently describes a bonus game of Jeopardy that is played on a second upper display.

I. VANCURA TEACHES AWAY FROM THE PENDING CLAIMS

MPEP Section 2141.02 states that prior art must be considered in its entirety, including disclosures that teach away from the claims. Specifically,

A prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention. *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984).

Vancura teaches away from the claims of the present application. As stated in Vancura itself:

Having the opportunity to **test a player's knowledge** of trivia, facts, surveys, pricing, and so forth **independent of a player's skill in a game of chance** would be a welcome addition to the casino experience.

Vancura, page 1, paragraph 8 (bold added). Vancura apparently is concerned solely with adding player skill to a casino game. Apparently, the overriding idea behind Vancura is to eliminate chance from the game and allow players to win based on their skill and knowledge. For example, in Vancura, apparently a question is asked and it is up to the player to select the correct answer even if it takes a significant amount of time for the player to answer. The element of chance apparently is purposely removed from Vancura.

In contrast, the claims of the pending application call for the electronics selection of the answer. The player does not use knowledge or skill to select the answer. The selection of the answer is entirely out of the hands of the user. As the patent application states,

The present invention generally relates to methods of playing games, such as wagering, casino games, that involve questions and answers and which, for example, **adapt the foregoing types of games into games of chance, not skill**, for play in a casino environment.

Application, page 4, lines 1-3 (bold added). The claims are drafted to cover just such a description as all the independent claims call for the answer to be selected electronically, not by the player.

In addition, by allowing a player to select the answer, Vancura does not control the flow and payout of the game as described in the pending claims. In Vancura, a player can take as much time as she deems necessary to answer a question. This would open up all sorts of negative possibilities, including greatly reducing the money flow through a gaming machine and allowing a player to consult with others including others not even at the casino. In terms of payout, by allowing a player to select the answer, the outcome is no longer random and cannot be predicted with much accuracy. A smart user could remember questions, research the answers, return to the machine and win a significant amount of money. In the claimed method, the electronic selection of the answer ensures the casino will maintain control over the flow and payout of the game.

In short, the claims of present invention call for the answer to the question to be selected electronically, without any human knowledge or skill affecting the selection. Vancura states its purpose is to add the use of the players knowledge and skills in selecting answers to questions. Clearly, Vancura is teaching away from the pending application.

II. MODIFIED VANCURA WOULD NOT BE FIT FOR ITS INTENDED PURPOSE

The proposed modification to Vancura by combining it with the "randomly selected answer" disclosed in Brossard would render Vancura unsatisfactory for its intended purpose. As MPEP 2143.01 states, the proposed modification cannot render the prior art unsatisfactory for its intended purpose :

If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. In re Gordon, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984).¹

Vancura is concerned with allowing a players knowledge and skill to completely dictate the outcome of the game. As explained in section I, by adding the random select of Brossard, Vancura would not be fit for its explicitly stated intended purpose of allowing the skill and knowledge of the player determine the outcome of the game as a player's knowledge and skill would no longer be the determining factor of whether a player would win at a game.

¹ Claimed device was a blood filter assembly for use during medical procedures wherein both the inlet and outlet for the blood were located at the bottom end of the filter assembly, and wherein a gas vent was present at the top of the filter assembly. The prior art reference taught a liquid strainer for removing dirt and water from gasoline and other light oils wherein the inlet and outlet were at the top of the device, and wherein a pet-cock (stopcock) was located at the bottom of the device for periodically removing the collected dirt and water. The reference further taught that the separation is assisted by gravity. The Board concluded the claims were prima facie obvious, reasoning that it would have been obvious to turn the reference device upside down. The court reversed, finding that if the prior art device was turned upside down it would be inoperable for its intended purpose because the gasoline to be filtered would be trapped at the top, the water and heavier oils sought to be separated would flow out of the outlet instead of the purified gasoline, and the screen would become clogged.

Accordingly, as modified Vancura would not be fit for its intended purpose, there is no suggestion or motivation to make the proposed modification.

III. MODIFYING VANCURA WOULD IMPROPERLY CHANGE ITS PRINCIPLE OF OPERATION

MPEP 2143.01 states the proposed modification cannot change the principle of operation of a reference. A principle of Vancura is that the player's skill and knowledge should determine the outcome of the game. Modifying Vancura by adding the random answer selection of Brossard would change the stated principle of operation as the outcome of modified Vancura no longer would be determined by the knowledge and skill of the player. Accordingly, such a modification is improper. As MPEP 2143.01 states in relevant part:

If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims prima facie obvious. In re Ratti, 270 F.2d 810, 123 USPQ 349 (CCPA 1959).²

As explained in section I, as the proposed combination of the prior art changes the principle of operation of Vancura from being skill based to being chance based, the teachings of the modified Vancura is not sufficient to render the claims prima facie obvious.

IV. VANCURA TEACHES AWAY FROM BROSSARD MAKING THE COMBINATION IMPROPER

In addition, Vancura teaches away from Brossard. As previously stated, Vancura is concerned with a game where the result is totally dependent on the skills and knowledge of the player, not a result of chance. In relevant part, Brossard recites, that "the win/loss outcome is at least partially affected by the skill or coordination of the player." Col. 11, lines 64-65. Ultimately, the outcome of Brossard is due to chance which is directly in conflict with the teachings of Vancura. As such, it is respectfully submitted that it is improper to combine Vancura and Brossard. As MPEP section 2145.X.D.2 states, references cannot be combined where the references teaches away from their combination. Specifically:

²Claims were directed to an oil seal comprising a bore engaging portion with outwardly biased resilient spring fingers inserted in a resilient sealing member. The primary reference relied upon in a rejection based on a combination of references disclosed an oil seal wherein the bore engaging portion was reinforced by a cylindrical sheet metal casing. Patentee taught the device required rigidity for operation, whereas the claimed invention required resiliency. The court reversed the rejection holding the "suggested combination of references would require a substantial reconstruction and redesign of the elements shown in [the primary reference] as well as a change in the basic principle under which the [primary reference] construction was designed to operate." 270 F.2d at 813, 123 USPQ at 352.

It is improper to combine references where the references teach away from their combination. In re Grasselli, 713 F.2d 731, 743, 218 USPQ 769, 779 (Fed. Cir. 1983).³

Pursuant to this section of the MPEP, as Vancura clearly teaches away from Brossard, it is improper to combine Vancura and Brossard. Therefore, the rejection of the pending claims based on the combination of Vancura and Brossard is improper and the claims should be allow.


In view of the foregoing, it is respectfully submitted that all claims in the present application are in condition for allowance.

For the foregoing reasons, reconsideration and withdrawal of the rejections of the claims and allowance thereof are respectfully requested.

Respectfully submitted,

March 4, 2003

By:



William J. Kramer
Reg. No. 46,229

Marshall, Gerstein & Borun
6300 Sears Tower
233 S. Wacker Dr.
Chicago, IL 60606
312-474-6300

³ The claimed catalyst which contained both iron and an alkali metal was not suggested by the combination of a reference which taught the interchangeability of antimony and alkali metal with the same beneficial result, combined with a reference expressly excluding antimony from, and adding iron to, a catalyst.